

REMARKS

Claims 1-62 are pending in the present application.

The objection to Claim 1 and the rejection of Claims 1-62 under 35 U.S.C. §112, first paragraph (written description), is respectfully traversed.

In the Office Action the Examiner has held that the exclusionary proviso in Claim 1 constitutes new matter and has required that we cancel the same. The Examiner alleges that “the limitations with the negative proviso are not present and shown in the original specification.” Obviously, this indication by the Examiner is an error as the exclusionary proviso explicitly appears in its current form in *original* Claim 1 and on page 3, line 20 to page 4, line 2.

Accordingly, Applicants request withdrawal of this ground of objection and rejection.

The rejection of Claims 33 and 34 under 35 U.S.C. §112, second paragraph, is obviated in part by amendment and traversed in part.

The Examiner has rejected Claims 33 and 34 alleging that the phrase “a substituent which can be converted into a hydrogen atom” is indefinite because the claim fails to recite exactly how reductive alkylation is conducted. To this end, Applicants note that the specification clearly defines the aforementioned substituent on page 10, lines 17-22. In addition, the specification clearly indicates that the reductive alkylation conditions are a matter of artisan’s choice and that the exact nature of the aforementioned substituent would be correspondingly selected based on the general knowledge readily available to the skilled artisan.

Further, Claims 31, 33 and 34 claim a process to reach an aldehyde with an aspartame under reductive alkylation conditions (e.g., H₂, Pd-C). The term "substituent" is, for example, a "benzyloxycarbonyl group," which is converted to a hydrogen atom by catalytic reduction (i.e., hydrogenolysis) under reductive alkylation conditions (e.g., H₂, Pd-C). The Examiner asserts that the reductive alkylation conditions is only conducted in the presence of NaB(OAc)₃H as described on page 11, line 19 of the specification. However, from the foregoing, this assertion is not correct as the "reductive alkylation conditions also include the above-mentioned catalytic reduction.

The specification further discloses "a reducing agent, such as a hydrogen/palladium carbon catalyst" at page 11, line 14. As such, Applicants have amended Claims 31, 33, and 34 to further define the phrase "a substituent which can be converted into a hydrogen atom" as being "under hydrogenation conditions."

Applicants submit that the claims are definite within the context of 35 U.S.C. §112, second paragraph. As such, withdrawal of this ground of rejection is requested.

The obviousness-type double patenting rejection of Claims 1, 3, 9, 12, 14, 16, 18-20, 24, 25, 29-31, 33-34, 37, 43, 46, 48, 50, and 58 over Claims 1-9 and 19-28 of US 6,649,784, is obviated by submission of an executed Terminal Disclaimer.

Applicants submit herewith a Terminal Disclaimer in compliance with 37 C.F.R. §1.321(c), disclaiming the terminal part of any patent granted on the above-captioned application, which would extend beyond the expiration date of the full statutory term as presently shortened by any terminal disclaimer of US 6,649,784. Accordingly, Applicants believe that this ground of rejection is no longer at issue and should be withdrawn.

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Acknowledgement to this effect is requested.

Applicants submit that the present application is in condition for allowance. Early notification to this effect is respectfully requested.

Respectfully submitted,

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